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EXAMINER

LEO, LEONARD R

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 10/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,295

Applicant(s)

LAVOCHKIN, RONALD B.

Examiner

Leonard R. Leo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

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DETAILED ACTION

The amendment filed February 8, 2002 has been entered. Claims 17-18 are cancelled, claims 1-16 and 19-32 are pending.

Reissue Applications

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Claims 1-16 and 19-32 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Claims 19-32 are rejected under 35 U.S.C. 251 for lack of defect in the original patent and lack of error in obtaining the original patent. See MPEP 1450.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 10-16 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1-6. When two claims in an application are duplicates or else are so close in content that

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they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

In claims 10-16, the recitation of “by being deformed using the channel as a mold” is considered to be a method limitation in an apparatus claim, which bears no patentable weight in this instance. Similarly, in claims 1-6, the recitation of “by a friction fit formed between said side walls and said fluid conduit” is considered to be a method limitation in an apparatus claim. Clearly, there is no structural difference between the final products being claimed.

Response to Arguments

The rejection under 35 U.S.C. 112, first paragraph is withdrawn.

Applicant’s argument that claims 1 and 10 are of substantially different scope is mistaken. Applicant’s statement, “*Claim 1 recites that the channel has “an outer span greater than the span across the open end of the channel”.*” is incorrect. The above statement refers to the “fluid conduit” in claim 1, lines 13-15. The recitation of “the open end of the channel having a span less than a span across a lower portion of the channel” in claim 1, lines 9-10 is the same as “the second ends of said side walls having a span less than a span across a lower portion of said channel” in claim 10, lines 7-8. The “second ends” as recited in claim 10 define the “open end of the channel.” Further, the recitation of claim 10 with respect to the manufacturability of the device is given no patentable weight in the final product claim. The final product of claim 1 and the final product of claim 10 having the same structural limitations are the same device.

Applicant’s remarks with respect to the declaration are unpersuasive.

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37 CFR 1.175(a)(1) states:

“(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, ***stating at least one error being relied upon as the basis for reissue;***”

MPEP 1414 (August 2001, 1400-22) states:

“Reissue oaths or declarations must contain the following:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid —

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, i.e., as the basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath /declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.”

Applicant has satisfied all requirements, except for the statement of at least one error. To merely restate section (A)(2) does not satisfy section (B). The criteria for the statement of at least one error is noted below.

MPEP 1414 (August 2001, 1400-23) states:

“II. A STATEMENT OF AT LEAST ONE ERROR WHICH IS RELIED UPON TO SUPPORT THE REISSUE APPLICATION (I.E., THE BASIS FOR THE REISSUE).

In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid.

Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.”

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Therefore, the general statement, "The claims covered less than applicant had the right to claim in the patent." is insufficient.

It is noted that applicant has no response with respect to the rejection of claims 19-32.

MPEP 1450 (August 2001, 1400-51) states:

"A reissue applicant's failure to timely file a divisional application is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such error is not correctable by reissue of the original patent under 35 U.S.C. 251. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). See also *In re Mead*, 581 F. 2d 251, 198 USPQ 412 (CCPA 1978). Likewise, if the original patent specification or the prosecution history of the original patent shows an intent not to claim the newly presented invention, that invention cannot be added by reissue. In these situations, the reissue claims should be rejected under 35 U.S.C. 251 for lack of defect in the original patent and lack of error in obtaining the original patent. See also MPEP § 1412.01."

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry of a general nature, relating to the status of this application or clerical nature (i.e. missing or incomplete references, missing or incomplete Office actions or forms) should be directed to the Technology Center 3700 Customer Service whose telephone number is (703) 306-5648.

Any inquiry concerning this Office action should be directed to Leonard R. Leo whose telephone number is (703) 308-2611.



LEONARD R. LEO
PRIMARY EXAMINER
ART UNIT 3743

October 10, 2002